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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,128	01/07/2002	Clifford A. Pickover	YOR9200100372US1	3989
48175	7590	10/18/2005	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER

3625

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/041,128

Applicant(s)

PICKOVER ET AL.

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,20,21,29 and 58 is/are pending in the application.
- 4a) Of the above claim(s) 3,6-19,22-28,30-57 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,20,21,29 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 3, 6 – 19, 22 – 28, 30 – 57 and 59 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8-1-05.

Applicant's election with traverse of the Restriction Requirement in the reply filed on 8-1-05 is acknowledged. The traversal is on the ground(s) that the claims are related. This is not found persuasive because the specification can not be read into the claims and the claims as recited are not related and that receiving is distinct from issuing, which as stated by the Applicant would require two different entities.

The requirement is still deemed proper and is therefore made FINAL.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 5, 20, 21 and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 36 of U.S. Patent No. 6,658,415 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims address an authority that provides approval for selecting and associating an item or content.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 2, 4 – 5, 20, 21, 29 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Chow (US 6,850,899 B1).**

Regarding claim 1 and related claim 58, Chow teaches a method for electronic shopping, comprising: receiving an instruction to associate an item with an electronic shopping cart; and in response to the instruction, determining that the item is not

allowed to be associated with the electronic shopping cart (see at least Abstract, Col 2, lines 42 – 45 and Col 4, lines 4 – 12).

Regarding claim 2, Chow teaches a method, wherein the determination is based on rules (Abstract).

Regarding claim 4, Chow teaches a method according, wherein the rules are based at least in part on a price of the item (Col 4, lines 7 – 8).

Regarding claim 5, Chow teaches a method, wherein the rules comprise a rule specifying that a price of all items in the shopping cart may not exceed a specified total price (Col 4, lines 8 – 10).

Regarding claim 20, Chow teaches a method, wherein the instruction is received from a consumer, and wherein the determining step comprises: determining whether approval of the association has been received from at least one of: a spouse of the consumer, a parent of the consumer; a law enforcement agency; a government entity; a legal guardian; an account holder; a credit card account holder; a co-signer on a credit card; a service bureau; a credit card company; a designated third party; a merchant; and an intelligent software agent (Col 4, lines 4 - 12).

Regarding claim 21, Chow teaches a method, wherein the step of determining whether approval of the association has been received is not performed for all items (Col 8 – 10).

Regarding claim 29, Chow teaches a method, wherein the item comprises at least one of merchandise, stocks, bonds, services and knowledge (Col 4, lines 4 – 9)

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**571-273-8300** [Official communications; including  
After Final communications labeled  
"Box AF"]

For general questions the receptionist can be reached at  
**571.272.3600**

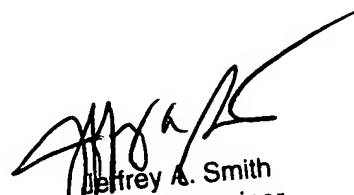
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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Jeffrey A. Smith  
Primary Examiner